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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,851	06/19/2000	Gary M. Diamond	99-109	4220

7590 12/31/2001

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EXAMINER

GARCIA, MAURIE E

ART UNIT	PAPER NUMBER
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1627

DATE MAILED: 12/31/2001

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/596,851

Applicant(s)
Diamond et al

Examiner
Maurie E. Garcia, Ph. D.

Art Unit
1627



-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Oct 15, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-69 is/are pending in the application

4a) Of the above, claim(s) 1-15, 39, and 59-69 is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims 16-38 and 40-58 are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other: _____

DETAILED ACTION

1. The Response filed October 15, 2001 (Paper No.7) is acknowledged. No claims were amended, cancelled or added. Therefore, claims 1-69 are pending.
2. Applicant's election of Group II (claims 16-38, 40 and 41) in Paper No. 7 is acknowledged. Applicants traverse the separation of Groups II and III. The traversal is addressed below (paragraph 5).
3. However, because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement between elected Group II and Groups I and IV-VI, the election has been treated as an election without traverse (MPEP § 818.03(a)) with respect to these groups.
4. Thus, claims 1-15, 39 and 59-69 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to non-elected inventions. Election was made **without** traverse in Paper No. 7 with respect to these groups.
5. Applicants traversal and request for combination of the instant Groups II and III has been considered and was found persuasive. However, upon further review of the instant case, it was determined that the application contains claims directed to patentably distinct species of the claimed invention and *additional* species elections are necessary

for purposes of search (i.e. those species elections required for both of previous Groups II *and* III). See MPEP 811.02. The requirement for election is set forth below.

Election/Restriction

6. The claims under consideration are those from previous Groups II and III (i.e. claims 16-38 and 40-58) since the groups are being combined.

7. Although the examiner agrees with applicants arguments with regard to the distinctness of the claims previously set forth as Groups II and III, there is a great deal of confusion as to the specific species of the claims since the terminology “determining polymerization performance” and “determining a property” (also “polymerization activity”) appears to be used interchangeably. Applicant’s Response filed October 15, 2001 seems to underscore this fact as applicant argues that there is no basis for restriction between these groups. However, it is noted that claims 44 and 53 recite “determining polymerization performance” but claim 42 recites “polymerization activity” is measured by “determining a property”. Claim 16 recites “polymerization activity” is measured by “determining polymerization performance”.

8. When reviewing the instant specification, it appears that “determining polymerization performance”, “determining a property” and also measuring “polymerization activity” all refer to the same process. It would greatly assist the examiner in the examination of the case on the merits to clarify this issue. Also, when

electing a species below, a description of whether “determining polymerization performance” or “determining a property” (or measuring “polymerization activity”) is being performed and the difference between these steps (if any) would also assist the examiner.

9. Also, upon further review, a specific election of *each* of the monomers (specific chemical structure) is also requested for purposes of search (see below).

10. Applicant is required to elect from the following patentably distinct species present in claims 16-38 and 40-58. Election from each species is required. Claims 16, 19, 24, 25, 28, 33 and 41-43 are generic.

Species of “method further comprising”

- | | |
|---|----------------------|
| A. Copolymerizing first and second monomers | claims 17 and 18 |
| B. Polymerizing second monomer | claims 20 and 21 |
| C. Polymerizing a second monomer with a third monomer | claims 34-36 (53-55) |

Species of “dispensing”

- | | |
|-----------|----------|
| A. Liquid | claim 26 |
| B. Gas | claim 27 |

First species of “determining polymerization performance”/ “determining a property”

- | | |
|-----------------------------------|------------------|
| A. Concentration | claim 45 |
| B. Polydispersity | claim 46 |
| C. High throughput chromatography | claims 47 and 48 |

Second species of “determining polymerization performance” / “determining a property”

- | | |
|---|--------------------------|
| A. Product (polymer sample) | claims 22, 23, 29, 44-49 |
| *** Also elect a single property from claim 29/49 | |
| B. Reaction mixture | claims 30, 50 |
| *** Also elect a single property from claim 30/50 | |

C. Polymerizing a second monomer
with a third monomer

claims 53-55

Species of monomer (claims 37, 38, 40, 56-58)

A ***specific*** structure for EACH monomer must be elected (first and second monomer; also third monomer, if present).

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the groups have different issues regarding patentability and represent patentably distinct subject matter.

11. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

12. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and ***a listing of all claims readable thereon***, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

13. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

14. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

15. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

16. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

17. Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR

1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie E. Garcia, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 8:30 to 6:00 and alternate Fridays.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

20. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Supervisory Patent Examiner, at (703) 308-2439. Thank you in advance for allowing us

to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

Maurie E. Garcia, Ph.D.
December 29, 2001

A handwritten signature in black ink, appearing to read 'Maurie E. Garcia', with a stylized, flowing script.

MAURIE E. GARCIA, Ph.D
PATENT EXAMINER



RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

PAGES, INCLUDING COVERSHEET:

PHONE NUMBER:

TO EXAMINER: Maurie E. Garcia, Ph.D.

ART UNIT: 1627

SERIAL NUMBER:

FAX/TELECOPIER NUMBER: (703) 308-4315

**PLEASE NOTE: THIS FACSIMILE NUMBER IS TO BE USED ONLY
FOR RESPONSES TO RESTRICTIONS.**

COMMENTS: _____

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